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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,895	07/15/2002	Jill Ann Williams	DLT 00002	1554

7590

03/12/2004

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EXAMINER

MANAHAN, TODD E

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,895

Applicant(s)

WILLIAMS ET AL.

Examiner

Todd E. Manahan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 8, 14, 15, 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-13, 16-20 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Response to Amendment

The Pre-amendment filed 11 February 2002 has been entered-in-part. The following portions of the amendment have not been entered:

The first amendment to page 2 was not entered because page 2 contained no paragraph beginning "All the materials require as much as possible..."

Likewise, the amendments to pages 16, 20, and 21 have not been entered because these pages do not contain the paragraphs where the amendments are to be entered as directed by applicant.

The amendment directed to creating a new page has not been entered because the Office can not add pages to applicant's specification.

Claims 1-21 filed 11 February have replaced claims 1-21 originally filed. Claims 1-23 are pending.

Information Disclosure Statement

Reference AGA listed on the IDS filed 11 February 2002, is applicants P T document of which the instant application is a 371 National Stage. It does not constitute prior art and should not be listed on PTO-1449. Likewise forms PCT/RO/101 and PCT/IPEA/416 should not be listed on the PTO-1449 as they do not constitute prior art.

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Claim Objections

Claims 8, 14, 15, 21 and 22 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not depend from another multiple dependent claims. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-20 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 16-20 and 23 provides for the use of a manufacture and use of a kit, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 16-20 and 23 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7/1-7/3, 9-11, and 12/9-12/11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (United States Patent No. 5,149,268) in view of Wilson et al. (United States Patent No. 5,611,793).

Johnson discloses the method of treating a dental root canal essentially as claimed except for the steps of introducing a flowable photosensitizer into the root canal and activating it with a light via an optical fiber. Wilson et al disclose a method of disinfecting tissues of the oral cavity comprising applying a photosensitizer to the surgically induced wound and thereafter exposing it to laser light via an optical fiber. It would have been obvious to one skilled in the art to provide the method of treating a dental root canal of Johnson with the steps of introducing a flowable photosensitizer into the root canal and activating it with a light via an optical fiber in view of Wilson et al in order to disinfect and sterilize the root canal prior to filling. Regarding the apparatus or kit claims, to provide all the equipment needed to perform the method of the combination of Johnson as modified by Wilson et al. would have been obvious to one skilled in the art in order to facilitate performing such method.

Claims 1, 4-6, 7/1, 7/4-7/6, 9, 10, 12/9, 12/10, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vari (European Patent No. EP 0830852 A1, cited by applicant)) in view of Wilson et al. (United States Patent No. 5,611,793).

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Vari discloses the method of treating a dental root canal essentially as claimed except for the steps of introducing a flowable photosensitizer into the root canal and activating it with a light via an optical fiber. Wilson et al disclose a method of disinfecting tissues of the oral cavity comprising applying a photosensitizer to the surgically induced wound and thereafter exposing it to laser light via an optical fiber. It would have been obvious to one skilled in the art to provide the method of treating a dental root canal of Vari with the steps of introducing a flowable photosensitizer into the root canal and activating it with a light via an optical fiber in view of Wilson et al in order to disinfect and sterilize the root canal prior to filling. Regarding the apparatus or kit claims, to provide all the equipment needed to perform the method of the combination of Vari as modified by Wilson et al. would have been obvious to one skilled in the art in order to facilitate performing such method.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd E. Manahan whose telephone number is 703 308-2695. The examiner can normally be reached on Mon-Fri.

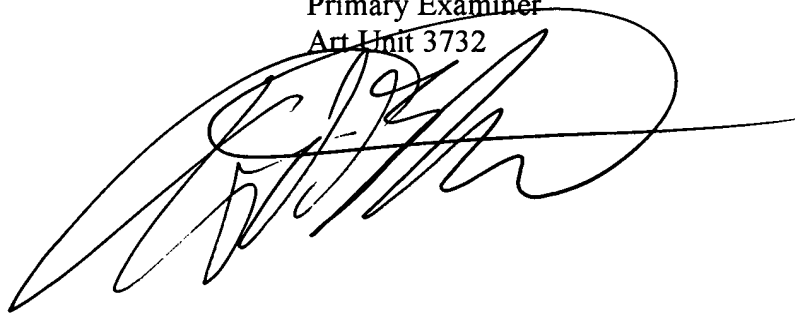
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 703 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Todd E. Manahan
Primary Examiner
Art Unit 3732

T.E. Manahan
5 March 2004

A large, stylized handwritten signature in black ink, likely belonging to Todd E. Manahan, is written over the printed name and title.